

REMARKS

This Application has been carefully reviewed in light of the Final Action mailed June 24, 2005. Applicant respectfully requests reconsideration and favorable action for this Application.

Claims 1-3 and 5-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bauman, et al. in view of Trull. Independent Claim 1 recites ". . . associating each entry after placement in the queue to one of a plurality of groups, each of the plurality of groups having a different transaction parameter criteria" By contrast, the Bauman, et al. places packets in its request buffer registers and removes packets therefrom based on either a FIFO priority or a register priority scheme. Under the FIFO priority scheme, every packet in register L0 is serviced first. In the register priority scheme, packets are grouped by type and then placed into specific request buffer registers that are assigned the corresponding packet type. Thus, under the register priority scheme, the Bauman, et al. patent groups its transfers prior to placement within its request buffer registers so that its groups can be inserted into corresponding request buffer registers and can be output from the corresponding request buffer registers in a first in first out basis. Thus, even with the use of the queuing operation of the Trull, et al. patent with the request buffer of the Bauman, et al., there would still lack an ability to group entries after placement into a queue as required by the claimed invention. Therefore, Applicant respectfully submits that Claims 1-3 and 5-7 are patentably distinct from the proposed Bauman, et al. - Trull combination.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bauman, et al. in view of Trull and further

in view of Garcia, et al. Independent Claim 1, from which Claim 4 depends, has been shown above to be patentably distinct from the proposed Bauman, et al. - Trull combination. Moreover, the Garcia patent does not include any additional disclosure combinable with the Bauman, et al. or Trull patents that would be material to patentability of these claims. Therefore, Applicant respectfully submits that Claim 4 is patentably distinct from the proposed Bauman, et al. - Trull - Garcia, et al. combination.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bauman, et al. in view of Trull and further in view of In re Yount. Independent Claim 1, from which Claim 8 depends, has been shown above to be patentably distinct from the proposed Bauman, et al. - Trull combination. Therefore, Applicant respectfully submits that Claim 8 is patentably distinct from the proposed Bauman, et al. - Trull - In re Yount combination.

Claims 9-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Meyers, et al. in view of Bauman, et al. and further in view of Trull. Independent Claim 9 recites ". . . associating entries after placement in the arbitration queue to one of a plurality of groups . . ." The Examiner readily admits that the Meyers, et al. patent fails to teach a collapsible arbitration queue. The Examiner cites the Trull patent to support a collapsible queue. However, the Trull patent places instructions into a queue without associating them with a group. To remedy this deficiency, the Examiner cites the Bauman, et al. patent for its grouping technique. However, as stated above, the Bauman, et al. patent groups its transfers prior to placement within its request buffer under the register priority scheme so that each group can be inserted into a specific register and can be output from the

specific register in a first in first out basis. Thus, even with the use of the queuing operation of the Trull, et al. patent with the request buffer of the Bauman, et al., there would still lack an ability to group entries after placement into a queue as required by the claimed invention. Therefore, Applicant respectfully submits that Claims 9-14 are patentably distinct from the proposed Meyers, et al. - Bauman, et al. - Trull combination.

Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Meyers, et al. in view of Bauman, et al. and Trull and further in view of In re Yount. Independent Claim 9, from which Claim 15 depends, has been shown above to be patentably distinct from the proposed Meyers, et al. - Bauman, et al. - Trull combination. Therefore, Applicant respectfully submits that Claim 15 is patentably distinct from the proposed Meyers, et al. - Bauman, et al. - Trull - In re Yount combination.

This Response to Examiner's Final Action is necessary to address the new grounds of rejection raised by the Examiner and the newly cited art in support thereof. This Response to Examiner's Final Action could not have been presented earlier as the Examiner has only now raised new grounds of rejection and cited new art not previously presented in this Application.

Applicant respectfully requests withdrawal of the finality of the present Office Action. "Before final rejection is in order a clear issue should be developed between the examiner and applicant." M.P.E.P. §706.07. A clear issue has not been developed between the Examiner and Applicant with respect to the Bauman, et al. patent as the Examiner has only now used the Bauman, et al. patent as the main support for the rejection of these claims. According to

M.P.E.P. §706.07, hasty and ill-considered final rejections are not sanctioned. "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." M.P.E.P. §706.07. "To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection." M.P.E.P. §706.07.

Applicant responded to the first Office Action of December 23, 2004 and overcame the Wooten, et al. patent as the primary reference used by the Examiner to reject these claims. Now the Examiner comes back with the Bauman, et al. patent in place of the Wooten, et al. patent which was available to the Examiner for consideration in the previous Office Action but which the Examiner did not use as a basis for any rejection of these claims in the previous Office Action. The Examiner now uses the Bauman, et al. patent in the same manner as the Wooten, et al. patent was used in the previous Office Action. Thus, the Examiner has not followed the M.P.E.P. where it states that "[s]witching from . . . one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance or a final rejection." Amendments to the claims in response to the previous Office Action did

not substantially change the subject matter of the claims to force the Examiner to now use the Bauman, et al. patent where it could not have been used in the previous Office Action. Based on this fact alone, the finality of the present action is premature.

As a result, Applicant has not been given the cooperation of the Examiner as required and has been denied an opportunity to fully address the Bauman, et al. and associated new grounds of rejection that could have been cited in the previous Office Action. By not providing Applicant the capability to fully respond to the Bauman, et al. patent without the assurance that the response would be considered and entered, the Examiner has prematurely cut off prosecution of the present Application. Applicant has not been given a full and fair hearing to which it is entitled and a clear issue has not been developed as required. Therefore, Applicant respectfully submits that the final rejection is premature and that the finality of the present Office Action be withdrawn.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

No additional fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees and/or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'Charles S. Fish', is written over the printed name.

Charles S. Fish

Reg. No. 35,870

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